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Reply to Office Action of August 24, 2004

### **REMARKS**

Firstly, Applicant earnestly appreciates Examiner for the arduous effort to examine the present application. Secondly, Applicant has incorporated all the limitations of claims 2 and 5 into claim 1 to get amended claim 1 defined patentably over the cited references and any combination thereof. Further, Applicant carefully reviews the present invention and the cited references, and respectfully submits that all other pending claims have also been placed in allowable position, for the following detailed reasons:

#### ***Claim Rejections Under 35 USC § 112***

In the final office action, Examiner states that in claim 1, lines 8-10, it is unclear to Examiner exactly. Specifically, how does the indexing means assure engagingly mating of the retention means with the receiving means to hold the pick up mechanism on the socket connector, and there is no structure associated with the indexing means to accomplish that function. Therefor, Examiner includes that claims 1, 2 and 5-10 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

#### ***Response to the Claim Rejections Under 35 USC § 112***

Claims 2 and 5 have been deleted without prejudice, and the rejections proposed thereto are moot.

As regulated in the last paragraph of 35 USC § 112, an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed as to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

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On the merits, the indexing means recited in amended claim 1 is fully and clearly supported by the specification. Specifically, as clearly recited in the paragraph [0017] amended in the response of June 2, 2004, the indexing is formed at one corner 2140 of the plate member 21, and in this preferred embodiment, the indexing is a bevel 2141 through cutting away a triangular part of the corner 2140. Moreover, the paragraph further describes that it should be understood that the indexing can have other alternative shapes, for example, arcuate and so on.

Furthermore, with the indexing formed on the plate member 21, the plate member 21 is asymmetrical relative to the longitudinal and the transverse axes thereof. Thus an operator can easily recognize a correct orientation of the pick up mechanism 2, thereby efficiently attaching of the pick up mechanism 2 onto the socket connector 1.

In view of the above detailed enough structure and action descriptions of the indexing, the indexing means should be allowed to be recited into amended claim 1 and is fully and clearly supported by the described structures and the equivalents known by those who are skilled in the art at the time the invention was made.

Accordingly, it is respectfully submitted that amended claim 1 particularly points out and distinctly claims the subject matter which Applicant regards as the invention, and the rejection thereto should be withdrawn.

For the same reasons stated above, all the other pending claims have been placed to comply with 35 USC § 112, second paragraph. Thus, the rejections to claims 6-10 should be withdrawn.

### *Claim Rejections Under 35 USC § 103*

Claims 1, 2 and 5-10 are rejected under 35 USC § 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter, AAPA) as disclosed on pages 1-2 and FIGS. 5 and 6 of the present application, in view of

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Bailey (US Patent No. 3,784,957)

Furthermore, in response to Applicant's argument of June 2, 2004, Examiner states that Bailey does not disclose the index can be used for "anti-mismating or orientation purpose", a recitation of the intended use of the claimed invention must result in a structure different between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235(CCPA 1967).

***Response to Claim Rejections Under 35 USC § 103***

Claims 2 and 5 have been deleted without prejudice, and the rejections proposed thereto are moot.

Applicant would like to clarify that the intended use of the indexing means is to shape the plate member asymmetrical relative to a longitudinal and a transverse axis lines, respectively, and assure engagingly mating of the retention means with the receiving means to hold the pick up mechanism on the socket connector. As stated Examiner, the indexing means can be used for anti-mismating or orientation purpose. However, the indexing means can be used not only for anti-mismating or orientation purpose, but also for assuring engagingly mating of the retention means with the receiving means to hold the pick up mechanism on the socket connector. The later special usage of the indexing means is the merit of the claimed invention per se.

In view of Bailey, there is no suggestion that the bevel 7 can have the later special usage benefiting from the indexing means recited in amended claim 1. Rather, the bevel 7 can just be used to lead the integrated circuit device (see col. 2, ll. 15 to 17).

Thus, Applicant respectfully requires Examiner to reconsider the response of

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June 2, 2004 in view of the above.

Further, neither Bailey nor AAPA discloses *the receiving means* that is notches defined in the socket connector for engagingly receiving the retention protrusions respectively, as, *inter alia*, recited in amended claim 1. Even though Bailey and AAPA can be combined as Examiner proposed in this office action, said combination fails to show or disclose the receiving means of amended claim 1 yet.

Thus, it is non-obvious to one skilled in the art, having Bailey and AAPA before him/her, to modify the pick up mechanism of AAPA by providing the indexing of Bailey to get the pick up mechanism as claimed in amended claim 1.

Accordingly, it is earnestly submits that amended claim 1 is defined patentably over AAPA, Bailey and any combination thereof and should be allowed.

Claims 6 and 7 are directly or indirectly dependent on amended claim 1 and hence should be allowed.

Regarding claim 8, it, *inter alia*, recites "an orientation mark is on a top side thereof in a vertical direction whereby it is easy for an operator to assure correct engagement of the first engaging devices with the second engaging device respectively, thereby to assemble the pick up mechanism to the socket with correct orientation".

Regarding amended claim 10, it, *inter alia*, recites "indexing means on a top side thereof to reshape the plate member to be equipped with an orientation function so as to make sure of non-interference between said retention means and said connector during assembling".

For the above clarification, the bevel 7 of Bailey can just be used to lead the integrated circuit device (see col. 2, ll. 15 to 17). There is nothing to suggest or

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imply the above-emphasized features respectively recited in claims 8 and 10. In addition, in view of AAPA, it does also fail to suggest or imply the above-emphasized features respectively recited in claims 8 and 10. Further, no concerned prior art is provided to suggest or imply the above-emphasized features.

Thus, it is earnestly asserted that the inventions respectively claimed in claims 8 and 10 first introduce the above-emphasized features onto the pick up mechanism, and bring good benefits, e.g. to assemble the pick up mechanism to the socket with correct orientation or to make sure of non-interference between said retention means and said connector during assembling.

Therefore, Applicant respectfully requires Examiner to reconsider the response of June 2, 2004, and earnestly submits that claims 8 and 10 have been defined patentably over the cited references and any combination thereof, respectively, and should be allowed.

The Examiner does notice the intention defined in claims 8 and 10 by stating “a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art”. Anyhow, the Examiner also states “If the prior art structure is capable of performing the intended use, then it meets the claim”. Applicant cannot fully agree with this viewpoint.

**(I) Applicant believes that this criterion refers to the “single reference” which discloses all limitations of the claimed invention and results in the “anticipation” rejection (rather than the “obviousness” rejection) even if such a single reference is non-analogous to the claimed invention.** This criterion can NOT be applied to the “obviousness” type rejection, of which there are at least two references involved by a “hypothetical” combination. **Applicant sincerely requests the Examiner take a further look at this criterion to confirm the application circumstances thereof.**

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(II) It should be noted that both AAPA and Bailey NEITHER addresses the problem, i.e., the orientation issue, NOR presents the solution, i.e., the beveled structure on the corner. The beveled structure of Bailey is only for indexing purpose which is non-analogous to the orientation issue.

(III) The Examiner implies that the teaching might be derived from the skilled person. Anyhow, the Examiner does not clearly show/prove such a skilled person would first acknowledge the problem, and successively easily apply the beveled structure of Bailey to solve this problem without involvement of any further thorough consideration. It should be noted that sometimes the problem-initiation/identification is critical as well as the problem-solution. The Examiner fails to prove both these two issues.

Based upon the foregoing (I), (II) and (III), claims 8 and 9 are believed to patentably distinguish over the cited references, and in condition for allowance.

Claim 9 is directly dependent on claim 8 and should, therefore, be allowed.

### *Conclusion*

For all the above reasons, Applicant earnestly asserts that all the pending claims are patentably distinguishable from the prior art. Therefore, Applicant respectfully submits that this application is now in condition for allowance, and that an action to this effect is earnestly requested.

Respectfully submitted,

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